

THE HONORABLE THOMAS S. ZILLY

U.S. DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON

STRIKE 3 HOLDINGS, LLC, a Delaware
corporation,

Plaintiff,

vs.

JOHN DOE, subscriber assigned IP
address 73.225.38.130,

Defendant.

NO. 2:17-cv-01731-TSZ

**DEFENDANT'S RESPONSE TO
PLAINTIFF'S MOTION TO COMPEL
DEFENDANT'S HARD DRIVES
(DOCKET 125)**

ORAL ARGUMENT REQUESTED

JOHN DOE subscriber assigned IP
address 73.225.38.130,

Counterclaimant,

vs.

STRIKE 3 HOLDINGS, LLC,

Counterdefendant.

I. INTRODUCTION

The key issue in this discovery motion is what compelling reason should allow Strike 3 to deviate from the Model ESI order that this district has adopted?

DOE is agreeable to having DOE's records custodian search on the Hard Drive for the words: *Vixen*, *Tushy*, and *Blacked* (the three brands that Strike 3's movies are marketed under.)

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DOE is also agreeable to search for extracted raw movie footage from the PCAP data that Strike 3's German computer company, IPP, recorded. DOE is also agreeable to search strings with the torrent file names of the 87 works at issue. In short, DOE is agreeable to almost any combination of relevant search strings.

What DOE does oppose is the wholesale access to the entire Hard Drive. This is neither required under the facts of this case nor is supported under the Amended Rule 26. The reason is that the entire hard drive¹ also contains the private and personal information of DOE.

Further, as Strike 3 has no claim for damages of infringement, removal and examination of the entire hard drive is not proportional to the needs of this case. Proportionality is the key factor in considering the scope of ESI discovery. Since relevant "search strings" will indicate whether there is infringing works or not, Strike 3 is not at any disadvantage employing a methodology that this district, and other districts, use as a model rule.

II. STATEMENT OF FACTS

Defendant provides a brief overview of the relevant evidence collected in this case and the issues that remain for trial. This overview is necessary in view of Rule 26's proportionality requirement.

A. Remaining Claims and Affirmative Defenses

This case started with a claim of copyright infringement of 80 to 87 pornographic works. (See Dockets 1 and 43). Strike 3's claim is that DOE used a computer to download these movies using a program called "Bittorrent". DOE challenged those claims and Strike 3 then dismissed their claim of copyright infringement without prejudice. (Docket 53).

DOE filed amended counterclaims for declaratory relief of non-infringement and abuse of process. (Docket 64). Strike 3 has answered the counterclaims. (Docket 65).

¹ There is only one drive at issue, the original drive and an "imaged" hard drive. See Expert Report of Michael Yasumoto.

Strike 3 contends in its motion that this discovery is relevant to Strike 3's counterclaim of non-infringement. (See Docket 125, Motion at Pg. 4, lines 23-24, Pg. 5, lines 1-3).

B. The Data Collected by Strike 3's IPP Monitoring System

Plaintiff employed a data collection firm, "IPP International", to record evidence of data activity at IP address 73.225.38.130. (See Fieser Decl, Docket 4-3, Garcia-Paeth Decl, Docket 82). The evidence collected by IPP² consists of:

- 1) A digital copy of the alleged infringed work. (approx. 100MB-200MB)
- 2) PCAP data (16KB data blocks)
- 3) File Names Titles of the infringed works.
- 4) Hash Values (Docket 43-1)

C. The Media at Issue

There are two classes of ESI at issue in this case:

- "ASUS Computer Hard Drive" - The ESI of DOE's Computer that was used on a daily basis for connecting to and communicating with the Internet. This device was imaged by forensics expert Michael Yasumoto to preserved evidence and to avoid claims of spoliation. Expert Yasumoto then prepared and served an Expert Report.

- "Goodwill Computer Hard Drives" - The ESI from computers and other miscellaneous media (uninstalled computers) from DOE's inventory of computers that he has purchased from Goodwill, eBay, etc.. In his retirement, DOE buys and fixes computers.

Strike 3 has limited this motion to the inspection of the ESI of the "ASUS Computer Hard Drive". (See Motion, Docket 126).

² Doe does not admit that IPP system collects information accurately, instead this is the data that Strike 3 contends IPP collected.

1 **D. The Expert Reports and Declarations concerning the ESI**

2 Strike 3 served three expert reports, by Mr. Bunting and Mr. Paige, on March 15, 2019,
3 the date required for expert disclosures. DOE timely served the Expert Report by Mr Yasumoto
4 on the same date. Mr. Yasumoto imaged the drive for evidence preservation in 2018 as there
5 were still claims of copyright infringement by Strike 3.

6 The Yasumoto Report identifies a single hard drive that was used as a source ESI. From
7 that hard drive a forensic copy was made. There are two drives, a source drive and a forensic
8 image drive.

9 **E. The Competing Protocols**

10 DOE's counsel has proposed an ESI protocol that mirrors the WDWA model ESI
11 protocol. Strike 3's counsel desires an ESI protocol that involves taking possession of the hard
12 drive and inspecting with few limitations, and failing to designate a people who will look at the
13 hard drive.

14
15 **III. STATEMENT OF ISSUES**

16 Has Strike 3 shown good cause to adopt inspection methodology that is differs from the
17 WDWA model ESI order and is different from what other Districts allow?

18
19 **IV. AUTHORITY AND ARGUMENT**

20 **A. Possession and Inspection of the Hard Drive is not supported by Amended Rule 26.**

21 Rule 26(b)(1) states:

22
23 Unless otherwise limited by court order, the scope of discovery is as follows: Parties may
24 obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or
25 defense and proportional to the needs of the case, considering the importance of the issues at
26 stake in the action, the amount in controversy, the parties' relative access to relevant information,
27

1 the parties' resources, the importance of the discovery in resolving the issues, and whether the
 2 burden or expense of the proposed discovery outweighs its likely benefit. Information within this
 3 scope of discovery need not be admissible in evidence to be discoverable.

4 This rule was amended in 2015 recognizing that certain electronic devices contain large
 5 amounts of private, privileged, and irrelevant information.

6 Since the amendment of Rule 26, decisions are driven by the multifactor test guided by
 7 the language of Rule 26. These factors are: 1) importance of the issues at stake in the action; 2)
 8 the amount in controversy; 3) parties' relative access to relevant information; 4) parties'
 9 resources; 5) importance of the discovery in resolving the issues; 6) whether the burden or
 10 expense of the proposed discovery outweighs its likely benefit. In short, what is often performed
 11 is a cost-benefit analysis of the six factors under Amended Rule 26.

12 In the 2016 case of *T.D.P. v. City of Oakland*, 16-cv-04132-LB, (N.D. Cal July 17, 2017),
 13 plaintiff brought a 1983 action against the City of Oakland for excessive police force. A dispute
 14 arose over the searching of ESI. *Id.* at pg 8. Plaintiffs in *T.D.P.* proposed the following targeted
 15 searches:

- 16 • "Plaintiffs request that this court order a search of the defendant officers' emails,
 17 cell phones, text messages, and social media for only 90 days following the
 incident for everything related to this incident, the Plaintiff, or the decedent."
- 18 • "Outside of the 90-day window, Plaintiff suggests using search terms including
 19 but not limited to 'Perkins', 'sideshow', 'gun', 'airsoft', 'air soft', 'weapon', 'officer
 involved shooting', 'OIS', 'shooting', and 'Bancroft.'"
- 20 • "Plaintiff also requests all emails concerning the incident to and from OPD
 21 investigators and command staff. Defendants' proposal to only use search terms is
 22 inadequate."

23 The key dispute was the adequacy of "keyword searches". *Id.* Magistrate Judge Beeler
 24 relied on the decision of her fellow Magistrate Judge Corley that confirming search strings were
 25 adequate and also removed the terms, "gun and weapon", from the search strings. *Id.*

26 In a patent infringement case involving water park slides, the Court allowed string
 27 searches on ESI. *Flowrider Surf, Ltd. v. Pac. Surf Designs, Inc.*, 15-cv-1879 (S.D. Cal.,

1 November 3, 2016). In *Flowrider* the Court entered an ESI order that limited the scope of search
2 terms. Despite that limitation, the searches returned tens of thousands of documents, mostly for
3 old and irrelevant documents. *Id.* at 17. The Court then modified its ESI order and the search
4 terms "reviv*," "abandon*," "expire*," "maintenance fee," "late fee," and "patent fee" , were
5 found to be overbroad and resulted.

6 Also, in a discovery dispute involving a lawyer accused of trade secret theft of “lemon
7 law” documents, the plaintiff was first able to determine that a former partner had made copies
8 of the document onto ESI when a partner left the firm. *FCA U.S. LLC v. Bullock*, 17-cv-13972
9 (E.D. Mich., January 18, 2019). In this case the Court acknowledged that hard drive imaging has
10 been allowed by other courts, but, the mere suspicion by the plaintiff that there was discoverable
11 information on ESI did require that these devices be imaged. The Court in *FCA* stated: “... *The*
12 *information that Bullock has on her computer is certainly important to FCA's claims in this*
13 *litigation. But the mere fact that FCA has asserted a trade secrets claim does not give it free*
14 *reign to examine all of Bullock's electronic devices....*” *Id.* at 9. Likewise, Strike 3’s mere
15 suspicion that there may be data does not compel imaging of the drive.

16 In a published case between Motorola and Hytera over a trade secrets dispute, the court
17 in Motorola stated: “...Forensic examination is generally regarded as a drastic step even in
18 general discovery. *See, e.g., John B. v. Goetz* , 531 F.3d 448, 460 (6th Cir. 2008) ("mere
19 skepticism that an opposing party has not produced all relevant information is not sufficient to
20 warrant drastic electronic discovery measures.")." *Motorola Solutions, Inc. v. Hytera Commc'ns*
21 *Corp.*, 314 F.Supp.3d 931, 939 (N.D. Ill., 2018).

22 The aforementioned cases involve real disputes where the plaintiffs have claims for
23 damages. In this case, Strike 3 has already dismissed their claims for infringement.
24
25
26
27

1 **B. The application of the Six Factors weighs in favor Doe’s proposed Search String**
2 **protocol and in line with the WDWA Model ESI order.**

3 In the analysis of each of the six factors as required under Rule 26:

4 Factor 1 - Importance of the issues at stake in the action - Currently the only issue is the
5 declaratory relief of non-infringement. DOE does not bear the burden of proof on infringement.
6 This issue has not been rendered moot because Strike 3 failed to dismiss without prejudice.
7 Strike 3 contends that data on the ASUS drive is important to prove the existence of infringement.
8 On this factor Strike 3 contends that “...any device evidencing that Plaintiff correctly identified
9 the IP address engaged in BitTorrent activity is important to the central issues and claims in this
10 case..” (Motion at 7). Strike 3’s position is either incomplete or non-sensical. The abuse of
11 process counter-claim has nothing to do Doe’s activity, rather it goes the misrepresentations made
12 to this Court after the Complaint was filed. Since DOE did not participate in these
13 misrepresentations, there is no information on his Hard Drive that could be discoverable. This
14 factor weighs in favor of DOE.

15 Factor 2 - Amount in Controversy - This is similar to factor #1. On the infringement
16 claim there are no copyright damages at issue. While DOE may be permitted to move for fees
17 as the prevailing party under the Copyright Act, the award of damages is for the Court to decide.
18 The evidence of finding the movies using “search strings” can be used to gather evidence to
19 negate a claim for attorney fees. Taking possession of the Hard Drive has no additional
20 evidentiary value. This factor weighs in favor of DOE.

21
22 Factor 3 - Parties’ relative access to relevant information - Strike 3 already has access to
23 significant information from the “IPP monitoring system.” IPP contends that it communicated
24 with Doe’s computer and captured “PCAP” data. Therefore parts of the PCAP data should
25 identically match what is on the hard drive.
26
27

1 Strike 3 already has significant evidence collected by their investigator IPP regarding
2 infringement. To confirm this evidence, Strike 3 could select certain data subsets from the IPP
3 collected, such as PCAP data, and request that it be matched against the hard drive contents.

4 DOE has been more than willing to apply Strike 3's search strings to the Hard Drive.
5 DOE can also apply search strings to other Hard Drives. This factor again weighs in favor of
6 DOE.

7
8 Factor 4 - Parties' Resources - Strike 3 has not calculated the expected cost involving the
9 inspection of the Hard Drive to determine if there are: 1) private financial information; 2)
10 privileged communications with counsel; 3) family photos; and 4) other irrelevant but sensitive
11 documents. DOE's counsel will have to review the Hard Drive for those documents and seek a
12 protective order or a stipulation. This cost is not accounted for in Strike 3's analysis.

13
14 Factor 5 - Importance of the discovery in resolving the issues - The evidence of
15 infringing files is possibly relevant to Strike 3's affirmative defense. The evidence of infringing
16 files does not implicate the abuse of process claim. See Factor 1.

17
18 Factor 6 - Whether the burden or expense of the proposed discovery outweighs its likely
19 benefit. - Strike 3 minimizes the cost of having to review the Hard Drive for the documents.
20 Since DOE has proposed an equally effective search methodology, the most cost-effective
21 method should be adopted.

22
23 **C. DOE's Custodian was willing to search and return records of "Vixen", "Tushy"**
24 **and "Blacked", and other data strings, but Strike 3 never proposed search terms**
25 **until this motion.**

26 DOE reached out in early 2018 to have the ESI issue resolve. Strike 3 ignored DOE's
27 request on the issue of ESI for an entire year. (Edmondson Declaration)

D. Michael Yasumoto's search of the Hard Drive is a Red Herring.

Plaintiff's experts, Bunting and Paige, have had access to this report for over two months. They did not file a rebuttal report objecting to the methodology used by Yasumoto by the required deadline. Experts Bunting and Paige did not propose alternative or superior search methodologies in the motion.

Strike 3 requests intrusive discovery about evidence of infringement by requesting that the Hard Drive be imaged and inspected. This may be appropriate if Strike 3 still had claims for infringement, but the case law does not support that position. But Strike 3 does not even have claims for infringement. No one force Strike 3 to abandon their claim of infringement.

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2 RESPECTFULLY SUBMITTED AND DATED this 3rd day of June, 2019.
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CERTIFICATE OF SERVICE

I, Adrienne D. McEntee, hereby certify that on June 3, 2019, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

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14 DATED this 3rd day of June, 2019.

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